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In re Application of :
BLUMENKOPF et al. : DECISION ON APPLICATION
Application No. 10/640,079 : FOR
Filed: 08/13/2003 : PATENT TERM ADJUSTMENT
Atty Docket No. PC10209B :
:

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. 1.705," filed June 18, 2008,¹ which is being treated as a petition under 37 CFR 1.705(b).

Applicant requests correction of the patent term adjustment from 348 days to 449 days partly on the basis of the Office taking in excess of three years to issue the patent.

The request for reconsideration of the patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PAIR screen to reflect that the correct patent term adjustment determination at the time of the mailing of the notice of allowance is **258 days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee

¹ This application was timely filed with payment of the Issue Fee on June 18, 2008.

is entitled to for Office failure to issue the patent within three years. See 37 CFR 1.703(b). It is noted that at the time of this decision the patent has not issued.

Applicant is given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within three years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of 37 CFR 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

On March 19, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 348 days. On June 18, 2008, applicant timely filed the instant request for reconsideration of the patent term adjustment. Applicant states that the patent issuing from this application is subject to a terminal disclaimer.

Applicant asserts that the applicant should have been assessed a delay of 90 days for the filing of a Request for Continued Examination (RCE) in response to the final Office action of August 10, 2007.

A review of the application history reveals that a final Office action was mailed on August 10, 2007. However, applicant filed a RCE on February 8, 2008, in excess of the three-month period from the mailing date of the final Office action. See 37 CFR 1.704(b). Thus, applicant failed to engage in reasonable efforts to conclude prosecution of this application. The period of adjustment should have been reduced by 90 days, the number of days in the period beginning on the day after the date that is three months after the date of mailing of the final Office action, November 11, 2007, ending on the date the reply was filed, February 8, 2008. See 37 CFR 1.704(b). Accordingly, an additional period of reduction of 90 days will be entered.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is **258 days** (352 days of Office delay - 94 days of applicant delay).

The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent.

Applicant is reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than three years after the filing date of the application that overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A) and 37 CFR 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to the Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.



Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration

Enclosure: Copy of updated PAIR screen

Day : Friday
 Date: 9/26/2008

Time: 09:37:55

PALM INTRANET

PTA Calculations for Application: 10/640079			
Application Filing Date:	08/13/2003	PTO Delay (PTO):	352
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	4
Post-Issue Petitions:	0	Total PTA (days):	258
PTO Delay Adjustment:	-90		

File Contents History					
Number	Date	Contents Description	PTO	APPL	START
70	09/26/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		90	
57	03/19/2008	MAIL NOTICE OF ALLOWANCE			
56	03/14/2008	ISSUE REVISION COMPLETED			
55	03/14/2008	DOCUMENT VERIFICATION			
54	03/14/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
53	03/14/2008	EXAMINER'S AMENDMENT COMMUNICATION			
52	03/14/2008	NOTICE OF ALLOWABILITY			
51	02/25/2008	DATE FORWARDED TO EXAMINER			
50	02/08/2008	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
49	02/25/2008	DATE FORWARDED TO EXAMINER			
48	02/08/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)			
47	02/25/2008	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
46	02/08/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
45	08/10/2007	MAIL FINAL REJECTION (PTOL - 326)			
44	08/06/2007	FINAL REJECTION			
43	05/30/2007	DATE FORWARDED TO EXAMINER			
42	05/21/2007	RESPONSE AFTER NON-FINAL ACTION			
41	02/21/2007	MAIL NON-FINAL REJECTION			
40	02/16/2007	NON-FINAL REJECTION			
39	11/22/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
38	11/22/2006	REFERENCE CAPTURE ON IDS			
37.7	11/22/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED	0	35	

37	11/22/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
36	12/08/2006	DATE FORWARDED TO EXAMINER			
35	11/22/2006	RESPONSE AFTER NON-FINAL ACTION	4	34	
34	08/18/2006	MAIL NON-FINAL REJECTION			
33	08/17/2006	NON-FINAL REJECTION			
32	06/07/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
31	06/14/2006	PARALEGAL TD ACCEPTED			
30.7	06/07/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED	0	27	
30	06/07/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
29	06/07/2006	TERMINAL DISCLAIMER FILED			
28	06/12/2006	DATE FORWARDED TO EXAMINER			
27	06/07/2006	RESPONSE AFTER NON-FINAL ACTION			
26	03/08/2006	MAIL NON-FINAL REJECTION			
25	03/06/2006	NON-FINAL REJECTION			
24	08/13/2003	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
23	01/13/2006	DATE FORWARDED TO EXAMINER			
22	12/12/2005	RESPONSE TO ELECTION / RESTRICTION FILED			
21	11/10/2005	MAIL SUPPLEMENTAL RESTRICTION / ELECTION REQUIREMENT			
20	11/09/2005	SUPPLEMENTAL RESTRICTION			
19	09/30/2005	MAIL RESTRICTION REQUIREMENT	352	-1	
18	09/28/2005	REQUIREMENT FOR RESTRICTION / ELECTION			
17	07/09/2004	CASE DOCKETED TO EXAMINER IN GAU			
16	03/10/2004	CASE DOCKETED TO EXAMINER IN GAU			
15	01/20/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
14	01/20/2004	CASE DOCKETED TO EXAMINER IN GAU			
13.7	08/13/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
13	08/13/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
12	08/13/2003	PRELIMINARY AMENDMENT			
11	11/10/2003	APPLICATION RETURN FROM OIPE			
10	11/10/2003	APPLICATION IS NOW COMPLETE			
9	11/10/2003	PRE-EXAM OFFICE ACTION WITHDRAWN			

8	11/10/2003	APPLICATION RETURN TO OIPE			
7	11/08/2003	APPLICATION DISPATCHED FROM OIPE			
6	11/10/2003	APPLICATION IS NOW COMPLETE			
5	10/30/2003	CASE CLASSIFIED BY OIPE			
4	10/30/2003	CLEARED BY OIPE CSR			
3	10/30/2003	CLEARED BY OIPE CSR			
2	10/02/2003	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	08/13/2003	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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